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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/876,704	06/07/2001	James S. Mrozinski	55870US002	9401
32692	7590	07/22/2004	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			TRAN, SUSAN T	
			ART UNIT	PAPER NUMBER
			1615	

DATE MAILED: 07/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/876,704	Applicant(s) MROZINSKI ET AL.	
	Examiner Susan T. Tran	Art Unit 1615	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 July 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1,4-10,12-15,18-33 and 35-72.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Response to Arguments

Applicant's arguments filed 07/07/04 have been fully considered but they are not persuasive.

The amendment to the claims filed on 07/07/04 does not comply with the requirements of 37 CFR 1.121(c) because it appears that nothing in the claims or specification were amended. Note claim 22, recites "(PRESENTLY AMENDED)", but it appears to be the same as claim 22 recited in the amendment dated 02/09/04.

Amendments to the claims filed on or after July 30, 2003 must comply with 37 CFR 1.121(c). Accordingly, the amendment has not been entered. Further clarification is suggested.

Applicant argues that with respect to the product claims, there are three critical aspects of the coating provided in the present invention which are not taught or suggested in the art.

First, the claims require film-forming polymer forming the coating is on a given face of the porous substrate where the coating does not penetrate through the porous substrate to the apposite face of the porous substrate. However, applicant has not amend the claims to recite the film-forming polymer forming the coating on one side of the substrate. It is noted that the presently presented claims recite "coating on at least a portion of at least one face" would permit the coating to be on *any* given face.

Accordingly, no criticality is seen in the intended future use of the limitation "coating does not penetrate through the porous substrate to the apposite face of the porous substrate" when the same result is obtained by Kondo, namely, an oil absorbent sheet

that has excellent oil absorbance, notable transparency, and can absorb a large amount of sweat and skin oil dissolved therein on the face (page 1, lines 10-14).

Second, Kondo does not teach adding any additional additive into that coating. Applicant further alleges that the additives described at page 4 lines 6-7, are the additives in the porous film material not additives to a coating on the porous film material. Again, applicant has not defined the additives to include agents that can deliver benefits to the skin or hair. Accordingly, no criticality is seen in the intended future use of the limitation "coating does not penetrate through the porous substrate to the apposite face of the porous substrate" when Kondo teaches the use of similar additives that benefit the skin, namely the skin-modifying agent (specification, pages 14-15). Thus, it is the position of the examiner that such wide range of components would permit one of ordinary skill in the art to, by routine experimentation select one of the components to combine with the coating. Fillers, binders, or *salicylic acid* is not unexpected/unusual to cosmetic prior art, especially skin care composition.

Applicant argues that the "additives" described at pages 9-10 are actually not additives, but rather alternative suggested coatings to place on one side of the oil absorbing wipe described in Kondo. In response to the applicant's argument, Kondo is relied upon for the teachings within his four-wall patent. The test for obviousness is not that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the teachings of the references would have suggested to those of ordinary skill in the art to by routine experimentation optimize the teachings within the four-wall patent. In response to applicant's argument that the

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examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Finally, the additive to the film-forming polymer of the claimed invention is an additive delivers a benefit to the skin or hair upon wiping. However, *mineral oil*, filler, and *organic acid* disclosed at pages 6-7 are well-known skin benefiting component. See for example Wu et al. using organic acid, such as salicylic acid in a formula useful for skin.

Applicant argues that the rejection fails to indicate how the method claims are taught in reference applied. The method claims require a coating solution of a specific viscosity ranges and percent solids which are indicated as critical to obtaining the physical structure claimed. Contrary to the applicant's argument, first, the physical structure is not being claimed. Second, the method claims require nothing more than the composition claims, in which they require the coating solution be coated on at least one phase of the substrate. Kondo at page 11 and the examples clearly disclose the coating solution and the coating techniques. Applicant alleges that the specific viscosity ranges are critical, however, applicant has not provide data showing that the coating solution of Kondo does not have the viscosity that would fall within the claimed ranges

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since Kondo teaches the use of similar film-forming polymer in a similar coating solution to obtain an oil absorbing sheet that has excellent oil absorbance, notable transparency, and can absorb a large amount of sweat and skin oil dissolved therein on the face (page 1, lines 10-14).

Applicant request a telephone interview with the Examiner and the Examiner's supervisor to determine what is necessary to further this case towards allowance. In response to applicant's request, applicant's attention is directed to the substance of the telephonic interview dated 11/06/03. In that interview, the Examiner suggested amendment to place this application in condition for allowance. Applicant has not amend the claims as suggested.



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